

REMARKS

The March 2004 Office Action objected to claim 5 as a duplicate of claim 3. The Office Action also rejected all claims under 35 U.S.C. 103(a) as being unpatentable over Raverdy et al. (U.S. Publication 2002/0069243, hereafter "Raverdy") and in view of Kamper (U.S. Patent 6,654,797, hereafter "Kamper").

Claim 5 has been amended to overcome the objection.

As per claims 1 and 22, the Office Action asserted that Raverdy teaches the following:

"A method for downloading data from a server to a computer" at the Abstract by downloading event content information to the user device;

"transmitting user preference and computer configuration information to the server" at [0012] by the user preferably providing an appropriate device profile to the event server for identifying various specific configurations and functionalities of the user device and at [0058] by the profiles may include any information related to a system user of user device;

"determining applications that can be supported by the computer configuration" at [0012] by the server to preferably optimize services and content that is directed towards the particular system user and user device; and

"downloading only supported applications to the computer" at [0031] by the server to download appropriate content information or other types of services related to a particular user community.

The Office Action also noted that:

Raverdy does not specifically teach "accessing user preferences from a Personal Universal Memory (PUM) card".

However, Kamper teaches using smart card to store and access configuration data at col. 3, lines 56-63.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kamper's reference with Raverdy's teaching by implementing smart card device to Raverdy's system. The implementation would have enabled Raverdy's system to flexibly configure thin servers or clients with a minimum addition of a removable, modifiable, wireless-enabled and standardized hardware and interface device.

Applicant respectfully traverses the Section 103(a) rejection. Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie*

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obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142.

First, the Examiner must show some suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Third, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974).

Finally, the teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaack*, 20 U.S.P.Q.2d 1438 (CAFC 1991).

Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on all three of the above requirements.

The Office Action failed to establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03. Applicant notes that Raverdy fails to show at least the determining applications that can be supported by the computer configuration and the downloading of only supported applications to the computer. Since these two claimed elements do not exist in Raverdy, the combination, even if proper as asserted by the Office Action, does not render the claims unpatentable.

Raverdy relates to a method for effectively providing user information from a user device that includes an event server that provides restricted access to various types of event content information and services related to a particular event or user community. A wireless portable user device may provide an access code to the event server at a particular event location through a wireless base station that is coupled to a local area network. A system user may thereby utilize the user device to access the event server for downloading appropriate event content information and related community services. The user device may provide one or more different types of profiles and other user feedback to the event server to thereby enable the event server to effectively associate the user device with appropriate event content or other types of related community services.

With respect to the claimed "determining applications that can be supported by the computer configuration", Paragraph 12 of Raverdy only indicates that "the event server may preferably optimize community services and community content that is directed towards the

particular system user and user device". However, community services and content are not application software. As noted in Paragraph 56 of Raverdy:

In the FIG. 3 embodiment, community module 332 may preferably be utilized by user device 114 to communicate with a community manager and a community database on event server 138 regarding various community services provided for one or more user communities. A user community may include any group of system users that share one or more common characteristics or interests. For example, a user community may include a group of system users that frequently attend events at a particular event location. In accordance with the present invention, event server 138 may preferably create a user community based upon various profiles that are provided to event server 138 from various user devices 114 in electronic system 110. The foregoing community manager and community database are further discussed below in conjunction with FIG. 6.

The community services in Raverdy relate to community events stored in a community database on the event server. The community services and the community content are not equivalent to application software. For example, Raverdy claim 32 lists examples of community services as "including at least one of a community database, an electronic community message service, and a real-time electronic community discussion forum, said event server associating said system user with said user community after receiving and analyzing said at least one profile from said user device, a community module of said user device then receiving said restricted access to said community services." Moreover, Raverdy does not show the determination of applications that can be supported by the computer configuration because he is not talking about software applications; but is talking about content and services, the use of which is dependent on a connection with the server. Since at least one element is missing from Raverdy, the rejection must fail and withdrawal of the rejection is requested. Additionally, Raverdy does not show applications that operate independent of the server, which when downloaded onto the mobile device can be operated independent of the server and independent of a connection with the server. Raverdy requires maintaining a connection with the server at all times.

As another independent basis for traversing the rejection, Raverdy fails to show the claimed downloading only supported applications to the computer. Paragraph 31 of Raverdy only indicates that a "system user may thereby utilize the user device to access the event server for downloading appropriate event content information or other types of community services related to a particular user community." Paragraph 58 only shows that "profiles 412 may include any information related to a system user of user device 114. In certain embodiments, profiles 412 may include a basic device profile that only describes basic functionality of user device 114. The foregoing device profile may typically be provided to event server 138 to gain access by a single user device 114 to basic services and content information."

As discussed above, community services and events are items residing in a database that can only be accessed while connected to the server. They are not the same as supported applications that are downloaded to the computer and that can run while the device is not connected to the server.

The Office Action failed to identify a reasonably successful modification to Raverdy using the Kamper reference teaching to arrive at the claimed method for downloading data from a server to a computer by accessing user preferences from a Personal Universal Memory (PUM) card; transmitting user preference and computer configuration information to the server; determining applications that can be supported by the computer configuration; and downloading only supported applications to the computer.

Although Kamper shows a smart card to store and access configuration data, Kamper's server does not use the data to download applications to a remote computer. Rather, the Kamper configuration data is used to update various settings in the server 118 as follows:

The server 118 is provided with boot instructions such that, upon power-up, the server 118 sends a request to the removable storage device reader 120 to read configuration data from the removable storage device inserted therein. This configuration data may include, for example, the IP address of the server, the hostname, the netmask, the gateway, domain and nameserver information for the server 118.

The configuration data is read from the removable storage device by the removable storage device reader 120 and provided to the server 118 via a wired or wireless connection between the removable storage device reader 120 and the server 118. In this way, the server 118 is configured using the configuration data read from the removable storage device.

Applying Kamper with Raverdy, one skilled in the art would have arrived at a system that stores community services and community contents stored in a community database on the event server and that the event server configures itself during power-up to read configuration data, including the IP address of the server, the hostname, the netmask, the gateway, domain and nameserver information for the server, from a smartcard that is inserted into a portable card reader connected to the server.

However, there is no suggestion in Kamper to modify Raverdy to arrive at claim 1's method for downloading data from a server to a computer by accessing user preferences from a Personal Universal Memory (PUM) card; transmitting user preference and computer configuration information to the server; determining applications that can be supported by the computer configuration; and downloading only supported applications to the computer. There is no suggestion in Kamper to modify Raverdy to arrive at claim 22's method for downloading data from a server to a computer, by accessing user preferences; transmitting user preference and computer configuration information to the server; determining applications that can be supported by the computer configuration; and downloading only supported applications to the computer.

Additionally, the Office Action failed to identify a reasonable expectation of success for a person with ordinary skill to modify Raverdy using the Kamper teaching to arrive at the claimed invention recited in claims 1 and 22.

In sum, the Office Action did not establish and support *prima facie* obviousness of claim 1 and claim 22 as required in *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976) because each of the three basic criteria was not met(i) some suggestion or motivation to modify Raverday with

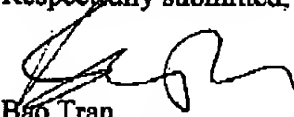
Kamper, (ii) a reasonable expectation of success, and (iii) teach or suggest all the claim limitations in Applicant's claim 1 and 22. Furthermore, no *apriori* knowledge existed to rationally derive claim 1 and claim 22 as required in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Hence, claim 1 and claim 22 as well as those dependent therefrom, are patentable over the references.

CONCLUSION

Applicant believes that the above discussion is fully responsive to all grounds of rejection set forth in the Office Action.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone Applicant's attorney at (408) 528-7490.

Respectfully submitted,



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